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|                                    |   |                     |
|------------------------------------|---|---------------------|
| In re Application of               | : | DECISION ON         |
| Kaslow, David C., et al.           | : |                     |
| Application No.: 09/554,960        | : |                     |
| PCT No.: PCT/US98/25742            | : | PETITIONS           |
| Int. Filing Date: 04 December 1998 | : |                     |
| Priority Date: 05 December 1997    | : | UNDER 37 CFR 1.181  |
| Attorney Docket No.: 15280-3421PC  | : |                     |
| For: VACCINES FOR BLOCKING         | : | AND 37 CFR 1.137(a) |
| TRANSMISSION OF PLASMODIUM         | : |                     |
| VIVAX                              | : |                     |

This decision is in response to "Request For Reconsideration of Petition Under 37 CFR 1.181 and 1.137(a)," filed in the United States Patent and Trademark Office on 09 September 2002.

**BACKGROUND**

On 04 December 1998, applicants filed international application PCT/US98/25742. On 01 July 1999, applicants filed a Demand for international preliminary examination, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty month period for paying the basic national fee in the United States expired on 05 June 2000.

On 22 May 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 23 June 2000, USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The Notification of Missing Requirements set a one month extendable time period for reply.

On 01 June 2001, USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the above-identified application was abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 23 June 2000.

On 09 October 2001, applicants filed the instant "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unavoidably Under 37 CFR 1.137(a)," which was accompanied by, *inter alia*, a declaration of Michele Simone, and a printout of an excerpt of the docket for 08/01/00 to 08/31/00.

On 01 February 2002, the Office mailed Decision on Petition Under 37 CFR 1.181 and 37 CFR 1.137(a).

On 09 September 2002, applicants filed the instant renewed petition along with a Certificate of Mailing under 37 CFR 1.8 and the fee for a four month extension of time.

### DISCUSSION

Applicants have provided conflicting certificates of mailing under 37 CFR 1.8. The transmittal form indicates that the correspondence was deposited on 23 July 2002. The statement by Jill R. Clarke is dated 30 August 2002 and the envelope is postmarked 30 August 2002. The certificates of mailing on the petition and on the declaration by Michele Simone indicate they were deposited on 30 August 2002. Applicants must explain these discrepancies. Without the benefit of the certificates of mailing, the reply will be untimely.

#### Nonreceipt of the Notification of Missing Requirements

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, 1156 O.G. 53 (Nov. 16, 1993). The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Items (1) and (2) were previously met.

Item (3) has not been met. Docket clerk Michele Simone states that "attached is an excerpt of the relevant part of the Docket identifying entries having a due date of July 23, 2000." Michele Simone must indicate that the docket record reflects all replies docketed for 23 July 2000. See MPEP §711.03(c). If this is not the case, applicants must provide a copy of the docket record for 23 July 2000 and indicate that it shows all replies docketed for 23 July 2000.

#### Petition to Revive Unavoidably Abandoned International Application for Patent

A petition to revive an application for patent unavoidably abandoned under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, (2) the petition fee, (3) a satisfactory showing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition to 1.137(a) was unavoidable and (4) a terminal disclaimer if application was filed before June 8, 1995.

Items (2) and (4) were previously met.

Item (1) has not been met. The required reply is an executed oath or declaration. The declaration submitted does not comply with 37 CFR 1.497(a)-(b) as the copy of the declaration executed by David Kaslow does not list all three inventors. The declaration must list all inventors and applicants are required to submit the declaration as executed by the inventors. No alteration, however minor, may be made to the declaration subsequent to its execution by the inventors.

Item (3) has not been met. As applicant has not established that the Notification of Missing Requirements was not received, it is assumed that it was received. As such, the delay was not unavoidable.

### CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The petition under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

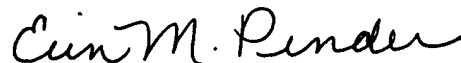
The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181 and 1.137(a)." No additional petition fee is required.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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